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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 10/660,334 | 09/11/2003 | Todd A. Bloomer | 006401.00040 | 5975 |

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EXAMINER

GREEN, ANTHONY J

ART UNIT PAPER NUMBER

1755

DATE MAILED: 05/05/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

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| | | | |
|------------------------------|--------------------------------------|--------------------------------|--|
| Office Action Summary | Application No. 10/660,334 | Applicant(s) BLOOMER | |
| | Examiner Anthony J. Green | Art Unit 1755 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 9-20 is/are pending in the application.
4a) Of the above claim(s) 17-20 is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 8-16 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date <u>02/03/05</u> . | 6) <input type="checkbox"/> Other: ____. |

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DETAILED ACTION

Response to Preliminary Amendment

1. The preliminary amendment has been entered. Claims 1-8 have been canceled and new claims 9-20 have been added. It should be noted that the use of the status identifier of "(now amended)" is not a proper status identifier. Also in order to show deletions either strikethrough or double bracketing (for less than 5 letters) must be used. Please make a note of this when responding to the office action.

Election/Restrictions

2. Restriction to one of the following inventions is required under 35 U.S.C. 121:
- I. Claims 9-16, drawn to a method of preventing a material from adhering to a surface and a method of preventing the freezing of aggregate material, classified in class 252, subclass 70.
 - II. Claims 17-20, drawn to a structure, classified in class 428, subclass various.

The inventions are distinct, each from the other because of the following reasons:

3. Inventions I and II are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions have different functions and/or effects. Group I is drawn to a method of using a composition whereas Group II is drawn to a structure and as such they are not related.

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4. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification and the search required for Group I is not required for Group II, restriction for examination purposes as indicated is proper.

5. During a telephone conversation with Allen Hoover on 26 April 2005 a provisional election was made without traverse to prosecute the invention of Group I, claims 9-16. Affirmation of this election must be made by applicant in replying to this Office action. Claims 17-19 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

Claim Rejections - 35 USC § 112

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7. Claims 9-16 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding claims 9 and 13, the phrase "such as" renders the claim indefinite because it is unclear whether the limitations following the phrase are part of the claimed invention and the scope of the claim is unascertainable. See MPEP § 2173.05(d).

Claim 11 is confusing as the step recited lacks proper antecedent basis as claim 9 makes no mention as to a step of mixing the composition with oil etc.

Claim Rejections - 35 USC § 102

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

9. Claims 9 and 12-16 are rejected under 35 U.S.C. 102(b) as being anticipated by Soviet Union Patent Specification No. 1664808A1.

The reference teaches, on pages 3, 5 and in the examples, the treatment of free flowing bulk materials with a composition comprising magnesium chloride, molasses residue etc. in order to prevent freezing and sticking of free flowing materials due to freezing.

The instant claims are met by the reference. It is the position of the examiner that the disclosure of the Soviet reference meets the instant claims. The statement of “applied to the operating surfaces of transportation facilities” found on page 5 and the teachings of Table 2 are believed to encompass the method of claim 9 as table 2 recites the application of the material to a conveyer belt. While it does not specifically recite “placing the material at a location for temporary storage” it does teach that it is added to the mass of free flowing bulk materials intended for storage so it is believed that this limitation is taught by the reference. Note example 1 which teaches the preventive

treatment of ore sinter in metal cases and the statement "added to the mass of free flowing bulk materials intended for storage" (i.e. these statements believed to meet the claimed limitation of temporary storage).

10. Claims 13-16 are rejected under 35 U.S.C. 102(e) as being anticipated by Schilling (US Patent No. 6,878,308 B2).

The reference teaches, in the abstract, column 1, column 3, lines 1-10, the examples and the claims, a method for inhibiting freeze clumping of aggregate materials by applying to the coal an anti-icing material comprising molasses solids such as desugared molasses solids in combination with a further freezing point lowering agent. Column 3, lines 1-10 teach that the composition can be sprayed onto the aggregate after the aggregate has been loaded into a railcar or truck.

The instant claims are met by the reference as the reference teaches a method that encompasses that which is instantly claimed.

11. Claims 13-16 are rejected under 35 U.S.C. 102(b) as being anticipated by Bloomer (US Patent No. 6,080,330).

The claims of the reference teach the use of a composition comprising desugared sugar beet molasses and another deicing component to surfaces. According to the abstract and column 4, line 22+, the types of surfaces contemplated include aggregate stockpiles etc.

The instant claims are met by the reference. The disclosure of an aggregate stockpile would meet the limitation of "placing the material at a location for temporary storage" as an aggregate stockpile is a temporary storage absent evidence showing otherwise.

Claim Rejections - 35 USC § 103

12. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

13. Claims 9-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Schilling (US Patent No. 6,878,308 B2).

The reference was discussed previously further column 1, lines 35+, teach that the prior art has taught to apply an anti-icing agent to the aggregate material and/or to the inside walls to the transporting equipment.

The instant claims are obvious over the reference. While the reference does not specifically teach the use of the anti-icing composition to treat the inside walls of the transporting equipment it does suggest that this has been done in the past. Accordingly it would have been obvious to one of ordinary skill in the art to utilize the composition of the reference to treat the surfaces used to transport the aggregate without producing any unexpected results as this is at least suggested by the prior art. As for instant claim

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11 the reference teaches the mixing of the composition with water which would render obvious this claim absent evidence to the contrary.

14. Claims 9-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bytnar (US Patent No. 6,468,442).

The reference teaches in the abstract, the examples and the claims, the use of a steepwater solubles composition to for reducing the buildup of snow and ice on a surface. According to column 3, lines 7+, the composition may also be used for pre-wetting or pretreating or stockpiles of solids to be used as anti-icing or deicing agents.

The instant claims are rendered obvious by the reference. While the reference does not specifically teach the use of the composition to treat aggregate stockpiles it does suggest that it may be used for pre-wetting or pretreating or stockpiles of solids and accordingly one of ordinary skill in the art would have found it obvious to utilize the composition to treat aggregate materials. As for the limitation of "placing the material at a location for temporary storage" since the reference refers to a stockpiles of solids it is believed that this would be considered to be a temporary storage absent evidence showing otherwise.

Information Disclosure Statement


15. The remaining references have been considered however they are do not appear to be any more pertinent than the art used in the above rejections.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Anthony J. Green whose telephone number is 571-272-1367. The examiner can normally be reached on Monday-Thursday 6:30-4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jerry Lorengo can be reached on 571-272-1233. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Anthony J. Green
Primary Examiner
Art Unit 1755

ajg
May 02, 2005